

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of

Carl L.C. Kah, III

Date: June 23, 2003

Serial No.: 09/686,197

Group Art Unit: 3752

Filed: October 10, 2000

Examiner: L. Morris

For: OPERATIONALLY CHANGEABLE MULTIPLE NOZZLES SPRINKLER

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL BRIEF TRANSMITTAL LETTER - FEE COMPUTATION

Sir:

Transmitted herewith in triplicate is an Appeal Brief in the above-identified application. The \$160.00 (small entity) fee is enclosed.

Applicants attach a Four-month Request for Extension of Time. The \$725.00 fee is also enclosed.

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account No. 15-0700.

If this communication is filed after the shortened statutory time period had elapsed and no separate Petition is enclosed, the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. §1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 C.F.R. §1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 15-0700.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 23, 2003:

Lawrence A Hoffman

Name of applicant, assignee or
Registered Representative

Lawrence A Hoffman
Signature

June 23, 2003

Date of Signature

Respectfully submitted,

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TECHNOLOGY CENTER R3700

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TECHNOLOGY CENTER R3700

**PETITION AND FEE FOR AUTOMATIC EXTENSION OF TIME
UNDER 37 CFR 1.17, 1.136(a) AND 35 USC 41(a)8**

Sir:

Applicant hereby petitions the Asst. Commissioner for Patents to extend the time for filing an Appeal Brief by FOUR (4) months. Enclosed is our check No. _____ which includes the amount of \$725.00 for the petition fee in accordance with 37 CFR 1.17 computed as:

X Response within fourth month_____ not small entity (\$1,450) X small entity (\$725)

You are authorized to charge to our Deposit Account No. 15-0700 any additional amounts owing.

If this petition is inadequate to avoid abandonment, the Assistant Commissioner for Patents is petitioned, under 37 C.F.R. §1.136(a), to extend the time by the number of months which will avoid abandonment under 37 C.F.R. §1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 15-0700.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 23, 2003:

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SignatureJune 23, 2003

Date of Signature

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Respectfully submitted,

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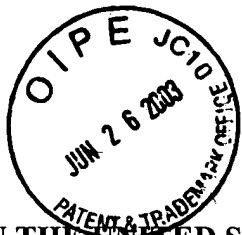
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Patent Application of

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Examiner: L. Morris

For: OPERATIONALLY CHANGEABLE MULTIPLE NOZZLES SPRINKLER

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

APPEAL BRIEF PURSUANT TO 37 C.F.R. §1.192

Sir:

This Appeal concerns the propriety of the Examiner's final rejection dated September 23, 2002, in connection with the above-identified reissue application. The Notice of Appeal was dated December 23, 2002.

I. STATUS OF CLAIMS:

Claims 1, and 4-30 are pending. Claims 1, 4-15, 20, and 22-30 have been finally rejected and are on appeal. Claims 16-19 and 21 have been allowed. The rejected claims are set forth in clean form in Appendix A hereto.

II. REAL PARTY IN INTEREST:

The real party in interest is the inventor, Carl L.C. Kah, III.

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III. RELATED APPEALS AND INTERFERENCES:

There are no related appeals or interferences.

IV. STATUS OF AMENDMENTS:

No amendments have been submitted.

V. BACKGROUND OF THIS APPEAL

A. Summary of the Invention

The present invention relates to an oscillating sprinkler which provides multiple nozzles having different flow rates and discharge trajectories that can be selectably changed while the sprinkler is installed, and in operation. Two basic constructions are disclosed and claimed. A first form, covered by claims 1-11, and 16-21, has a multi-orifice nozzle plate which is rotatably mounted on a cylindrical nozzle housing to change nozzles.

A second form, is covered by claims 12-15, and 22-30. Here, a nozzle plate having at least one orifice, fits slidably into a complementary groove formed in the rotatable nozzle housing, and is slidably removable to change nozzles.¹

Claims 1-15, and 18-21 include limitations defining a sealing structure which prevents leakage between the selectable nozzles and a flow path through the nozzle housing. Claims 16-17, and 22-30 do not recite a sealing structure.

B. Procedural History of this Application

This is an application filed under 35 U.S.C. 251 for reissue of U.S. Patent 5,826,797 (the '797 patent), issued October 27, 1998 in the name of Carl L.C. Kah, III. The underlying application for the '797 patent, Ser. No. 08/405,033 (the '033 application) was filed on March 16, 1995 with ten claims, and was ultimately allowed with 19 claims after several of the original claims were amended, others were cancelled and additional claims were added.²

1. Claim 22 is broad enough to cover both forms.

2. The application became abandoned due to an unintentional failure to pay the issue fee. A Petition to Revive accompanied by a terminal disclaimer of the final ten

On September 29, 1999, a third-party Request for Re-examination of the '779 patent was filed under 35 U.S.C. 302. The request was granted, and the re-examination was undertaken. After amendments not germane to this appeal, a Reexamination Certificate was duly issued on April 3, 2001.

The instant reissue application was filed on October 10, 2000, within the two year period permitted for broadening the original claims under 35 U.S.C. 251.

During the prosecution of this application, claims 1, 4-15, 20, and 22-30 were finally rejected under 35 U.S.C. §251 as being an impermissible attempt to recapture subject matter abandoned during the prosecution of the '033 application. There were no rejections in this application based on prior art.

VI. ISSUE TO BE DECIDED IN THIS APPEAL:

Whether the examiner was correct in finally rejecting claims 1, 4-15, 20, and 22-30 under the "recapture rule".

VII. GROUPING OF CLAIMS:

For purposes of this appeal, the claims may be grouped as follows:

Group I: Claims 1, 4-11, and 20

Group II: Claims 12-15

Group III: Claims 22-30

The claims in each group stand or fall together. For convenience, each group will be considered separately.

VIII. ARGUMENT:

A. Introduction

According to the recapture rule, a patentee may not regain by way of reissue, claims which are broader or of the same scope as claims which were cancelled or narrowed by amendment during

months of the '779 patent was filed, and ultimately granted.

prosecution of the original application, *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 2201 U.S.P.Q. 289, 295 (Fed. Cir. 1984). *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 27 U.S.P.Q.2d 1521, (Fed. Cir. 1993). However, for the recapture rule to apply, claims must be "broader than the original patent claims in a manner *directly pertinent to the subject matter surrendered* during prosecution" *id.*, 998 F.2d at 996, 27 USPQ2d at 1525, *In re Clement*, 131 F.3d 1464, 45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997). As demonstrated below, the recapture rule is not applicable because the rejected claims are not broader than the patent claims in a manner directly pertinent to surrendered subject matter.

In re Clement, supra, describes a three-step analytical process to be followed in applying the recapture rule. The first step is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Once it has been determined that cancellation or amendment of claims resulted in surrender of subject matter, it is determined whether the surrendered subject matter has crept into the reissue claim. *In re Clement, supra*, 131 F.3d at 1968, 45 U.S.P.Q. 2d at 1164.

B. Reissue Claims 1, 4-11, and 20.

According to the final rejection, applicant violated the recapture rule by broadening patent claim 1 in respect to a limitation added to original claim 1 of the '033 application in an amendment filed August 8, 1996 (Amendment A) and by deleting a limitation added in an amendment filed January 15, 1997 (Amendment B).

Table One below shows claim 1 as originally filed in the left column, patent claim 1, including the changes resulting from Amendments A and B, and from reexamination in the center column, and reissue claim 1 in the right column. The changes resulting from Amendment A, Amendment B, and reexamination are highlighted in blue, yellow and pink, respectively. In each instance, deleted text is shown struck through and added text is underlined.

ORIGINAL CLAIM 1	REEXAMINED CLAIM 1	REISSUE CLAIM 1
<p>A sprinkler having a rotatable nozzle housing;</p> <p>nozzle means in a separate rotatable sleeve which is slidably installed around the nozzle housing from the top of the sprinkler</p> <p>to provide a sealed connection to the pressurized water passage of the nozzle housing.</p>	<p>A sprinkler having comprising: a rotatable nozzle housing having a water passage formed therein an output shaft mechanically connected to said rotatable nozzle housing for rotating said nozzle housing; a manually adjustable rotatable sleeve having an inner surface and a plurality of circumferentially spaced orifices*; nozzles, each of said nozzles having mutually different configurations from each other;</p> <p>nozzle means in a separate rotatable sleeve which</p> <p>said rotatable sleeve is being slidably installed around the nozzle housing and being in rotational relationship therewith and thereto from the top of the sprinkler</p> <p>so that said rotatable sleeve can be selectively positioned to align one of said plurality of nozzles with the discharge end of the water passage for distributing water outwardly from said sprinkler;</p> <p>sealing means surrounding the discharge end of the water passage formed in said nozzle housing, said sealing means including a seal member surrounding the discharge end of the water passage and dimensioned to continuously bear against said inner surface of said rotatable sleeve</p> <p>to provide a sealed connection to the pressurized water passage of the nozzle housing, wherein said rotatable sleeve is selectively positioned to align one of said plurality of orifices with said discharge end of the water passage for distributing water outwardly from said sprinkler; and </p> <p> means for retaining said nozzle selection sleeve in place;</p>	<p>A sprinkler comprising: a rotatable nozzle housing having a water passage formed therein; an output shaft mechanically connected to said rotatable nozzle housing for rotating said nozzle housing; a manually adjustable rotatable sleeve having an inner surface and a plurality of circumferentially spaced nozzles, each of said nozzles having mutually different configurations from each other,</p> <p>said rotatable sleeve being slidably installed around the nozzle housing and being in rotational relationship therewith and thereto</p> <p>so that said rotatable sleeve can be selectively positioned to align one of said plurality of nozzles with the discharge end of the water passage for distributing water outwardly from said sprinkler; and</p> <p>sealing means surrounding the discharge end of the water passage formed in said nozzle housing, said sealing means including a seal member surrounding the discharge end of the water passage and dimensioned to continuously bear against said inner surface of said rotatable sleeve</p> <p>to provide a sealed connection to the pressurized water passage of the nozzle housing.</p> <p>and</p> <p>means for retaining said nozzle selection sleeve in place;</p>

* Added by Amendment A, but deleted during reexamination

TABLE ONE

1. Whether and in What Respect Reissue Claim 1 is Broader Than Patent Claim 1:

Considering the first step in the *Clement* analysis, from Table One, it may be seen that relative to Amendment A, reissue claim 1 differs from patent claim 1 in that (a) the phrase:

sealing means surrounding the discharge end of the water passage
formed in said nozzle housing, said sealing means including . . .

was deleted, and (b) “a seal member” was changed to - - a seal - -. Relative to Amendment B, reissue claim 1 was changed by (c) adding the word - - and - -, and (d) deleting the limitation “and means for retaining said nozzle selection sleeve in place”.

It is applicant’s position that reissue claim 1 is broader than patent claim 1 only in respect to change (d). Changes (a) and (b) do not broaden patent claim 1.³

a. Change (a):

This pertains to the description of how the selected nozzle is sealed to the nozzle housing to prevent leakage. Although the limitation in question is written in means plus function form, it is not governed by 35 U.S.C. 112, paragraph 6, because it contains a recitation of the structure sufficient for performance of the identified function. *IMS Technology Inc. v. Haas Automation Inc.* 206 F3d. 1422, 54 U.S.P.Q. 2d. 1129 (Fed. Cir. 2000).⁴

Thus, the claim element in question is structural, and logically, the words:

sealing means surrounding the discharge end of the water passage
formed in said nozzle housing

in the element:

sealing means surrounding the discharge end of the water passage
formed in said nozzle housing, said sealing means including a seal
member surrounding the discharge end of the water passage and
dimensioned to continuously bear against said inner surface of said
rotatable sleeve

3. Change (c) is obviously trivial, and requires no discussion.

4. Patent Office procedures for interpretation of means plus function recitations are consistent with the *IMS* case. See *M.P.E.P. § 2181*, Rev. 1, Feb. 2003, at page 2100-214.

can not refer to any structure different from than the seal member itself. Therefore the deleted phrase is substantively redundant.

This interpretation is supported by the specification (see col. 3, lines 14-30) which refers to an O-ring, i.e., a single element as providing the seal. While applicant does not concede that the seal is to be limited to the O-ring disclosed, e.g., for purposes of the doctrine of equivalents, there is certainly nothing in the record which can reasonably be interpreted as being part of a “sealing means surrounding the discharge end of the water passage” except for the recited seal member.

Even if the text deleted by change (a) is not considered redundant, and/or the limitation as a whole is held to be governed by 35 U.S.C. 112, sixth paragraph, deleting the means plus function phrase has the effect of *narrowing*, rather than broadening the claim. As stated by the court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 589, 56 USPQ2d 1865, 1888 (CA FC 2000), *Vacated on other grounds*, 535 U.S. 722, 62 USPQ2d 1705 (US SupCt 2002)

A claim element recited in means-plus-function language literally encompasses the corresponding structure and its equivalents. *Laitram Corp. v. Rexnord Inc.*, 939 F.2d 1533, 1536, 19 USPQ2d 1367, 1370 (Fed. Cir. 1991). In contrast, a claim element that recites the corresponding structure does not literally encompass equivalents of that structure. *Id.* Thus, a claim amendment that replaces means-plus-function language with language reciting the corresponding structure narrows the literal scope of the claim. (emphasis added).

Reissue claim 1 can accordingly not be considered broader than patent claim 1 in respect to change (a).

b. Change (b):

This pertains to what the seal is called. The prosecution history demonstrates that reissue claim 1 is not broader in this respect than patent claim 1. Amendment A was submitted in response to an Office Action dated May 6, 1996, in which original claim 1 was rejected as being anticipated by the Balister U.S. Patent 3,094,283. In distinguishing over the Balister, applicant’s representative argued:

As noted in Balister, the gasket 23 is located just under the cap. Applicant’s *seal* is in a different location and serves a different function albeit that both are seals... The Examiner’s attention is

called to the fact that the claims as originally presented included the *sealing element* as one of the necessary elements in the combination. (emphasis added)⁵

From this argument, it should be inferred that applicant considered ‘a seal’ (as implicitly recited in original claim 1) to be verbally and physically the same as a “sealing element” referred to in the Remarks, and the same as “a seal member” as it was expressed in Amendment A.

This interpretation is completely consistent with general, as well as technical English usage. Typical dictionary definitions of the word seal include:

... a tight and perfect closure (as against the passage of gas or water); a device to prevent the passage or return of gas or air into a pipe or container *Merriam-Webster On Line Dictionary*, <http://www.m-w.com/dictionary.htm>;

(1) any device or system that creates a nonleaking union between mechanical ...elements...(2) a tight perfect joint, *McGraw-Hill Dictionary of Scientific and technical Terms*, Fifth Ed.1994, McGraw-Hill, Inc.

In terms of the disclosed O-ring, it is clear that “seal” and “seal member” must be regarded as legally equivalent, and that in this context, the word “member” is redundant. Reissue claim 1 can accordingly not be considered broader than patent claim 1 in respect to change (b).

2. Whether the Broadened Aspect of Reissue Claim 1 Relates to Surrendered Subject Matter.

“To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.”. *In re Clement, supra*, 131 F.3d at 1469, 45 U.S.P.Q. 2d at 1164 (citing *Mentor Corp., supra*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25).

a) Amendment A:

As demonstrated above⁶, the recapture rule cannot be properly applied with respect to changes (a) and (b) of reissue claim 1, because these are not broadening changes. However, even

5. See Amendment A, page 8.

6. See pages 6-7.

if the changes are considered to be broadening, the recapture rule is still not applicable because these changes are not “directly pertinent” to surrendered subject matter, *Mentor, supra*.

Comparing the left and center columns of Table One, as shown in blue, Amendment A changed original claim 1 by (i) addition of the means plus function clause describing the seal between the discharge end of the water passage and the nozzle sleeve, and (ii) by changing “a seal member” to - - a seal - -. ⁷

(i). Change(i):

When considered as a whole as required by *Mentor, supra*, it is apparent that claim 1, as originally filed, called for the nozzle means to provide “a sealed connection”. It is also apparent that the effect of change (i) was to specify the location of the seal (“surrounding the discharge end of the water passage”) and to explicitly recite one of its physical characteristics (“dimensioned to continuously bear against said inner surface of said rotatable sleeve”). The seal itself, however, was always recited in claim 1, at least inferentially.

This interpretation is clearly supported by the Remarks accompanying Amendment One, in which it was stated:

Nor does [Balister] appear to be concerned with the leakage problem inherent in the design of any water sprinkler. As noted in Balister, the gasket 23 is located just under the cap. Applicant’s seal is in a different location and serves a different function albeit that both are seals... *The Examiner’s attention is called to the fact that the claims as originally presented included the sealing element as one of the necessary elements in the combination.* The claims have been amended to more definitely define this element which clearly distinguishes over Balister (emphasis added). ⁸

To provide an antecedent basis for the added features, the seal was explicitly recited, but that was incidental, and certainly cannot be considered as limiting the claim. The seal was always implicitly recited, and applicant always intended claim 1 to cover a seal, *In re Amos*, 953 F.2d 613, 619, 21 USPQ2d 1271, 1276 (Fed. Cir. 1991). Making explicit what was previously implicit does not narrow a claim. See *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 61

7. Other changes are not relevant to the issues on appeal.

8. See Amendment A, page 8.

U.S.P.Q. 2d 1152, 1157 (Fed. Cir. 2001) (“we conclude that the addition of the words “transform calculation” was not a narrowing amendment because that addition did nothing more than make express what had been implicit in the claim as originally worded. That interpretation flows from the original claim as a whole and in light of the specification.”).⁹ Accordingly, change (i) narrowed claim 1 only in respect to location of the seal, and its construction. Even if removal of the means plus function language from reissue claim 1 (by change (a)) is treated as broadening, it is clearly not directly pertinent to the subject matter surrendered by change (i). The language in reissue claim 1 concerning the location and character of the seal is identical to that in patent claim 1.

(ii) Change (ii):

Since claim 1 originally recited a seal at least inferentially, claim 1 was not narrowed by reciting the seal explicitly, *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, *supra*. It was also not narrowed by naming this element as a seal member in Amendment A, and was not broadened again by renaming it, as just a seal in reissue claim 1. There is no difference between a seal and a seal member.¹⁰

(b) Amendment B.

Further inspection of Table One shows that the element “means for retaining said rotatable sleeve in place”, deleted from reissue claim 1 (change (d)) was added to claim 1 by Amendment B. Applicant concedes that this addition did narrow the scope of original claim 1.

Careful consideration will reveal, however, that the subject limitation was not added to claim 1 to distinguish it from the prior art. Indeed, in retrospect, the change appears to have been the result of careless housekeeping.

In the Office Action dated October 29, 1996, claims 1 and 9 (*inter alia*) were rejected under 35 U.S.C. 102 as anticipated by the Saint-Raymond French patent 2,313,132. Claim 9 as originally

9. The court in *Interactive* also referred to *Warner-Jenkinson, v. Hilton-Davis Chem. Co.*, 520 U.S. 17, at 33, 41 USPQ2d 1865, at 1873 (1997); *Turbocare Div. of Deman Delaval Turbomach. Corp. v. Gen. Elec. Co.*, 264 F.3d 1111, 1125-26, 60 USPQ2d 1017, 1028 (Fed. Cir. 2001) (holding that addition of the word “contact” to a claim did not narrow the claim . . . because another claim phrase, “small diameter position,” when read in light of the specification, necessarily implied “contact.”).

10. See discussion above, pages 7-8.

presented, including the limitation “means for retaining said rotatable sleeve in place” (hereinafter, the “retaining means limitation”), was dependent on claim 6, but that claim had been cancelled by Amendment A. Thus, at the time of the October 29, 1996 Office Action, claim 9 had no parent.

This informality was noted and objected to by the Examiner in Section 1 of the October 29, 1997 Office Action, and applicant responded in Amendment B by cancelling claim 9, and incorporating it into claim 1. In the Remarks, it was argued that claim 1 was patentable over Saint-Raymond on the basis of several structural differences.

Among these differences was the fact that applicant’s nozzle housing (16) was rotational, and to emphasize this, the limitation:

an output shaft mechanically connected to said rotatable nozzle housing for rotating said nozzle housing

was added.

In the Remarks, this was referred to by noting:

To clearly define the rotational movement of the housing the claims have been amended to recite shaft 5 to clearly define over the reference.¹¹

As claim 9 originally included this limitation, along with the “retaining means” limitation, it appears that Applicant’s representation decided to solve the depending problem for claim 9 simply by incorporating it into claim 1.

The record does not reveal whether inclusion of output shaft 5 was instrumental in persuading the Examiner to allow claim 1. More likely, it was all the arguments together. It is clear, however, that inclusion of the retaining means limitation had nothing to do with it. For one thing, this limitation was never mentioned in applicant’s arguments. More importantly, however, this limitation does not distinguish the claim over the Saint-Raymond patent. Sleeve 32 of Saint-Raymond has means for retaining it in place.

Realistically, any attempt to determine at this point why the retaining means limitation from claim 9 was not placed in a separate claim dependent on claim 1, would be pure speculation. Nevertheless, it is certain that the reason had nothing to do with patentability, or with the rejection

11. See Amendment B, page 4.

of claims 1 and 9, since the retaining means limitation does not, and never was alleged to, distinguish over the Saint-Raymond patent.

The mere fact that claim 1 was amended during the prosecution of the '033 application, and then further amended in this application is not a sufficient reason to invoke the recapture rule. The retaining means limitation could not have been added to claim 1 to overcome prior art, so applicant is not foreclosed from reconsidering the wisdom of this amendment. Applicant has determined that adding the retaining means limitation was an error, and there is no basis for the examiner to question applicant's assertion that the error was without deceptive intention.

3. Whether Surrendered Subject Matter has Crept into Reissue Claim 12:

Original claim 1 is broader than patent claim 1 only in respect to the details of the seal (change (i)). Reissue claim 1 is not broader than patent claim 1 in this respect as it includes identical language relative to the seal. It is also not broader because "seal" and "seal member" are legally and substantively equivalent. Original claim 1 is broader than patent claim 1 in that it does not include the retaining means limitation. Adding the retaining means limitation was not, however, a surrender of subject matter to distinguish over prior art. Therefore, omission of this limitation from reissue claim 1 is irrelevant.

The recapture rule is accordingly not applicable, and the final rejection of reissue claim 1 should be reversed.

B. Reissue Claims 12-15:

Patent claim 12 was added to the '033 application as claim 19 in Amendment A. According to the final rejection, applicant violated the recapture rule by deleting a limitation of patent claim 12, and thereby broadening reissue claim 12, in respect to subject matter surrendered during the prosecution of an *entirely different* claim.

Table Two below shows original claim 2 in the left column, claim 19 (patent claim 12) in the center column, and reissue claim 12 in the right column.¹² Additions to patent claim 12 in reissue

12. Claim 19 was not amended during the prosecution of the '033 application, and patent claim 12 was not amended during the reexamination.

claim 12 are underlined, and deletions are shown struck through. The text in patent claim 12 pertinent to this appeal is italicized. The recapture rule has not been invoked relative to other changes in patent claim 12

1. Whether and in What Respect Reissue Claim 12 is Broader Than Patent Claim 12:

Considering again the first step in the *Clement* analysis, from Table Two, it may be seen that, in pertinent part, reissue claim 12 differs from patent claim 12 in that the phrase:

sealing means surrounding the discharge end of the water passage
formed in said nozzle housing, said sealing means including . . .

was omitted. This is also one of the purportedly broadening changes in reissue claim 1 (referred to above as change (a)).¹³ As in the case of reissue claim 1, it is applicant's position that this change does not broaden reissue claim 12. The arguments in support of this position are precisely the same as those advanced in connection with change (a) above, they will not be repeated.¹⁴

2. Whether the Broadened Aspect of Reissue Claim 12 Relates to Surrendered Subject Matter.

As in the case of change (a) in reissue claim 1, it is applicant's position that the recapture rule can not properly be applied to the omission of the sealing means clause in reissue claim 12 because this is not a broadening change. Again, however, as in the case of reissue claim 12, even if this change is treated as broadening, the recapture rule is still not applicable because this change is not directly pertinent to subject matter surrendered to avoid prior art.

Looking again to the prosecution history as required by *In re Clement, supra*, it may be seen that claim 19 was added to the '033 application by Amendment A as a replacement for claim 2 which had been rejected as anticipated by Beamer U.S. Patent 4,235,379 in the Office Action dated May 6, 1996. This claim is directed to the second form of the invention as described above, i.e., having the slidably removable nozzle plate.

13. See page 6.

14. See pages 6-7 above.

ORIGINAL CLAIM 2	PATENT CLAIM 12	REISSUE CLAIM 12
A sprinkler having	A sprinkler having	A sprinkler having <u>comprising</u> :
a rotatable nozzle housing;	a rotatable nozzle housing having a central axis about which said rotatable nozzle housing rotates;	a rotatable nozzle housing having <u>a water passage formed therein and</u> a central axis about which said rotatable nozzle housing rotates; <u>and</u>
nozzle means in a separate plate which is insertable from the top into the nozzle housing	a relatively flat nozzle plate having a front side, a back side, a top edge, a bottom edge and opposing side edges; at least one orifice disposed in said nozzle plate aligning with a water passage formed in said rotatable nozzle housing for discharging water from the side of said rotatable nozzle housing at a given characteristic,	a relatively flat nozzle plate having a front side, a back side, a top edge, a bottom edge and opposing side edges; at least one orifice disposed in said nozzle plate <u>aligning to be aligned</u> with a the water passage formed in said rotatable nozzle housing for discharging water from the side of said rotatable nozzle housing at a given characteristic,
	said nozzle plate slidably fitting into a complementary groove formed in said rotatable nozzle housing and disposed generally parallel to said central axis, said front side having a planar surface facing the discharge end of said water passage,	said nozzle plate slidably fitting into a complementary groove formed <u>into said water passage</u> in said rotatable nozzle housing and disposed generally parallel to said central axis, said front side having so that a planar surface <u>of said nozzle plate can be sealed to the water passage by facing the discharge end of said water passage;</u>
	<i>sealing means surrounding said discharge end of said water passage formed in said nozzle housing; said sealing means including</i>	sealing means surrounding said discharge end of said water passage formed in said nozzle housing; <u>said sealing means including</u>
to provide sealed connection of the nozzle to the nozzle housing pressurize* water.	<i>a seal member surrounding the discharge end of the water passage and dimensioned to continuously bear against said planar surface to provide a sealed connection to the pressurized water passage of the nozzle housing,</i>	a seal member surrounding the discharge end of the water passage and dimensioned to continuously bear against said planar surface to provide a sealed connection to the pressurized water passage of the nozzle housing,
	means on the top edge of said nozzle plate accessible from the top of said rotatable nozzle housing	means on the top edge of <u>wherein</u> said nozzle plate <u>is</u> accessible from the top of said rotatable nozzle housing
	wherein said nozzle plate is removable while said sprinkler is operational for insertion of other nozzle plates with different orifices having different flow characteristics	wherein said nozzle plate is so as to be removable while said sprinkler is operational for insertion of other another nozzle plates with different orifices <u>plate having at least one orifice and</u> having different flow characteristics <u>from those of the removed nozzle plate</u> .

* Thus in the original. In Amendment A, the examiner objected to this, noting that it should be changed read "pressurized" .

TABLE TWO

In Amendment A, it was stated that claim 19 was “patterned after claim 2”¹⁵ and arguments were presented to distinguish various features of claim 19 from the Beamer patent. Among these distinctions was that “the cited reference fails to teach the sealing means claimed by applicant”, and in particular that “Beamer does not teach utilizing an “O” ring bearing against the front face of the nozzle plate. . .”¹⁶

The examiner responded in the Office Action dated October 29, 1996 by stating that claim 19 (and dependent claims 20-22) would be considered allowable if rewritten to include all the limitations of the base claim and any intervening claims.¹⁷ Claims 19-22 were ultimately allowed as claims 12-15 of the '797 patent.

From Table Two, it is apparent that like claim 1, claim 2 as originally filed, called for the nozzle means to provide “a sealed connection”. It is also apparent that, as in the case of claim 1, the effect of including the description of the sealing structure in claim 19 (the entirety of which is italicized for convenient identification) was to specify the location of the seal (“surrounding the discharge end of the water passage”) and to explicitly a physical characteristic thereof (“dimensioned to continuously bear against said inner surface of said rotatable sleeve”).

Again, as in the case of claim 1, the explicit recitation of a seal in claim 19 does not narrow the claim where predecessor claim 2 recited the seal inferentially, *Interactive Pictures Corp. v. Infinite Pictures, Inc., supra*. It must therefore be concluded that in respect to the sealing structure, claim 19 is narrower than original claim 2 only to the extent that it specifies the location and physical characteristics of the previously recited seal.

3. Whether Surrendered Subject Matter has Crept into Reissue Claim 12:

As demonstrated above, claim 19 is narrower than original claim 2 only to the extent that it specifies the location and physical characteristics of the previously recited seal. Since these limitations have been retained without change in reissue claim 12, there is no aspect in which reissue claim 12 seeks to recover surrendered subject mater. Moreover, omission of the means plus function

15. See Amendment A, page 10.

16. See Amendment A, page 11.

17. The examiner evidently overlooked the fact that claim 19 was already in independent form. This error was not mentioned subsequently in the prosecution by the examiner or applicant’s representative.

clause from reissue claim 12 does not broaden this claim in a manner *directly pertinent to subject matter surrendered* during prosecution", *Mentor, supra*,¹⁸ and the final rejection of claims 12-15 should accordingly be reversed.

C. Addition of Reissue Claims 22-30

According to the final rejection, applicant further violated the recapture rule by adding claims 22-30 to this application. The examiner held that these are broader than patent claims 16-19.¹⁹

1. Whether and in What Respect Reissue Claims 22-30 are Broader Than Patent Claims 16-19:

Table Three below shows patent claim 16, and independent reissue claims 22 and 29. All of these claims recite the combination of (a) a riser (which permits the upper end of the sprinkler to extend during operation and to retract when the sprinkler is shut off), (b) a rotatable nozzle housing, (c) a drive shaft for rotating the housing, and (d) a nozzle selection mechanism. The claims differ mainly in respect to the nozzle selection mechanism, and it is in this respect, that the determination must be made as to whether claims 22-30 are broader than claim 16-29.

18. Also as explained above, this change does not even broaden patent claim 12 in a manner that is *not* directly pertinent to the subject matter surrendered during prosecution, because the deleted text is substantively redundant in the context of the claim, or alternatively has the effect of narrowing the claim, *Festo, supra*.

19. These claims were added to the '033 application in Amendment A as claims 23-26.

PATENT CLAIM 16	PRESENT CLAIM 22	PRESENT CLAIM 29
A water sprinkler comprising:	A sprinkler comprising:	A sprinkler comprising:
a riser assembly;	a riser assembly;	a riser assembly;
	a rotatable nozzle housing having a flow passage formed therein for discharging water therefrom;	a rotatable nozzle housing having a flow passage formed therein for discharging water therefrom;
a drive shaft extending from the top of said riser assembly;	a drive shaft extending from the riser assembly and connected to the nozzle housing for rotating the nozzle housing relative to the riser assembly; and	a drive shaft extending from the riser assembly and connected to the nozzle housing for rotating the nozzle housing relative to the riser assembly; and
a nozzle housing assembly having a housing connected to said drive shaft for rotation therewith, a cylindrical outer surface, and a flow passage formed therein which has an exit at said cylindrical outer surface; and		
a cylindrical nozzle selection sleeve mounted over the outer surface of said housing to rotate therewith and being manually rotatable relative to said housing,	at least one selectable nozzle arrangement for aligning one of a plurality of nozzle orifices with the flow passage to distribute water from the sprinkler according to desired flow characteristics,	a nozzle plate including a selected orifice therein to be aligned with the flow passage for discharging water from the rotatable nozzle housing according to a desired flow characteristic.
said nozzle selection sleeve having a sleeve wall with a multiplicity of individual nozzles spaced therearound, said individual nozzles having mutually different configurations from each other to produce respectively different flow characteristics and being positioned on said sleeve wall so that each nozzle becomes aligned with said flow passage exit as the nozzle selection sleeve is rotated.	wherein the plurality of nozzle orifices are each configured mutually differently to provide different flow characteristics, and wherein a selected one of the plurality of nozzle orifices to be aligned with the flow passage can be changed while the sprinkler is operational.	

TABLE THREE

Like patent claims 12-15, reissue claims 23-30 cover the form of the invention in which nozzle selection is provided by a sliding plate. Patent claims 16-19 cover the form in which nozzle selection is provided by the rotating sleeve.

In finally rejecting claims 22-30 herein, the examiner argued that these claims are broader than claims 16-19 “because they do not call for the nozzle selection²⁰ to surround the nozzle housing and riser”.²¹ It makes no logical or legal sense, however, to say that a claim comprising elements **a**, **b**, and **c** is broader than a claim comprising elements **a**, **b**, and **c'** where **c** and **c'** are mutually exclusive variants of the same element. Neither claim dominates the other, and neither of elements **c** and **c'** is encompassed within the other.

So too, in respect to reissue claims 23-30, and patent claims 16-19. The two types of nozzle selection elements are mutually exclusive. Accordingly, reissue claims 23-30 are neither broader nor narrower than patent claims 16-19.

Reissue claim 22, on the other hand, is generic to both forms of nozzle selection elements. This is the only one of claims 22-30 which can legitimately be considered to be broader than patent claims 16-19.

2. Whether the Broadened Aspect of Reissue Claim 22 Relates to Surrendered Subject Matter.

Claims 23-26 were added to the '033 application by Amendment A to cover the “riser/nozzle housing configuration with the selection sleeve. . .”²² Since there were never any claims in the application directed to this configuration before claims 23-26 were added, it is simply not understood how the Examiner concluded that “the nozzle selection sleeve limitation was added to claims 23-26 in response to a rejection . . .”²³ Moreover, claims 23-26 were never amended, so it is not correct that the nozzle selection sleeve limitation was added to these claims. In any case, the prosecution

20. An editing error in Amendment A was evidently carried over into the subsequent Office Action. “Nozzle selection” probably should have read - - nozzle selection sleeve - - .

21. See Office Action dated September 23, 2002, page 3.

22. See Amendment A, page 7.

23. See Office Action dated September 23, 2002, page 3.

history of the '033 application does not even suggest that the limitation in question was *included* in these claims to distinguish over prior art.

In the office action of October 29, 1996, claims 23-26 were rejected as being unpatentable over the Kah U.S. Patent 4,867,378 in view of the Saint-Raymond patent discussed above. No changes were made in these claims in Amendment B, but in the remarks, arguments were presented to show that it would not have been obvious to a person skilled in the art to combine the references. Nowhere in the arguments was it ever stated or suggested that a patentable feature of these claims was the nozzle sleeve.

Moreover, consideration of the original claims 1-10 filed in the '033 application reveals that original claim 4 was also generic to both forms of nozzle selection elements. Claim 4 read:

A sprinkler housing; multiple nozzle means to allow selective placing a desired nozzle in the sprinkler flow path to provide the desired spray pattern.

While this might not be a model of clarity, the recitation “multiple nozzle means to allow selective placing a desired nozzle in the sprinkler flow path” can certainly be understood to cover both a single sleeve with multiple nozzles, and multiple plates with single nozzles. Reissue claim 22 is better written, but the “selectable nozzle arrangement” of this claim is the direct structural equivalent of the “multiple nozzle means” of original claim 4.

The examiner rejected original claim 4 as anticipated by Balister. This patent discloses a lubrication delivery device very different from the present invention. Nevertheless, the patent does show an element (cap 14) which has multiple selectable openings 24 for lubrication delivery. This reads as well on the multiple nozzle means of claim 4 as it does on the “cylindrical nozzle selection sleeve” of patent claim 16, and the “selectable nozzle arrangement “ of reissue claim 22.

In short, a nozzle selection sleeve is present in Balister, as well as in Saint-Raymond. Whether it is recited generically as the multiple nozzle means of original claim 4, or specifically as the cylindrical nozzle selection sleeve of application claim 23/patent claim 16, this is not what made application claim 23 patentable. Instead, it was the combination of elements i.e., the riser assembly, the drive shaft, the nozzle housing assembly, and the nozzle selection sleeve, together with the recited interactions between the elements. Accordingly, it can not be said that including the nozzle selection sleeve in application claim 23/patent claim 16 constituted a surrender of subject matter.

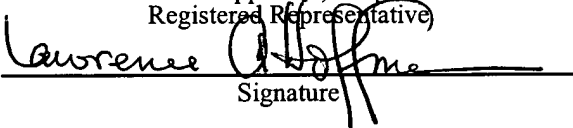
3. Whether Surrendered Subject Matter has Crept into Reissue Claim 22:

Since the inclusion of the nozzle selection sleeve in application claim 23/patent claim 16 did not represent a surrender of subject matter, the fact that reissue claim 22 recites the nozzle selection element more broadly, i.e., in generic terms, is not an improper attempt to recover subject matter which was surrendered during the prosecution of the '033 application, *Mentor Corp. v. Coloplast, Inc., supra.* Further, claims 23-30 are not broader than patent claims 16-19 in any respect. The recapture rule is accordingly not applicable, and the final rejection of claims 22-30 should be reversed.

IX. CONCLUSION:

It has been clearly demonstrated that the final rejection is based on an improper interpretation of the recapture rule. It is therefore respectfully requested that the decision of the examiner finally rejecting claims 1, 4-15, 20, and 22-30 be reversed and that this application be passed to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on June 23, 2003:

Lawrence A Hoffman
Name of applicant, assignee or
Registered Representative


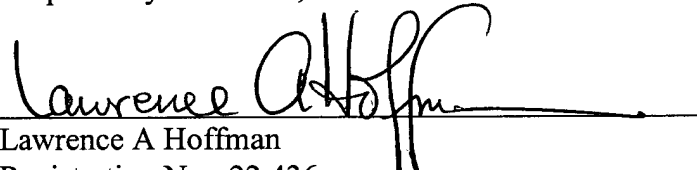
Signature

June 23, 2003

Date of Signature

LAH:sks

Respectfully submitted,



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APPENDIX A
CLAIMS ON APPEAL²⁴

CLAIMS:

1. (Amended) A sprinkler [having] comprising:

a rotatable nozzle housing having a water passage formed therein;

an output shaft mechanically connected to said rotatable nozzle housing for rotating said nozzle housing;[,]

5 a manually adjustable rotatable sleeve having an inner surface and a plurality of circumferentially spaced [orifices] nozzles, each of said nozzles having mutually different configurations from each other,; said rotatable sleeve [is] being slidably installed around the nozzle housing and being in rotational relationship therewith and thereto so that said rotatable sleeve can be selectively positioned to align one of said plurality of nozzles with the discharge end of the water passage for distributing water outwardly from
10 said sprinkler; and

[[sealing means surrounding the discharge end of [a] the water passage formed in said nozzle housing,;] said sealing means including]] a seal [[member]] surrounding the discharge end of the water passage and dimensioned to continuously bear against said inner surface of said rotatable sleeve to provide a sealed connection to the pressurized water passage of the nozzle housing;

15 [, wherein said rotatable sleeve is can be selectively positioned to align one of said plurality of orifices with said discharge end of the water passage for distributing water outwardly from said sprinkler,] [[and means for retaining said [nozzle selection] rotatable sleeve in place]].

2. (Canceled)

3. (Canceled)

4. (Amended) A sprinkler as claimed in claim [3] 1, wherein said [[sealing means]] seal is an "O" ring.

24. Single underling and bracketing show the reexamination changes relative to the original patent claims. Double bracketing and underlining show the reissue changes.

9. A sprinkler as set forth in claim [3] 1, wherein said rotatable nozzle housing includes indicia on the top indicating the location of each orifice of said plurality of orifices and/or its flow characteristic.

12. (Amended) A sprinkler [[having]] comprising:

a rotatable nozzle housing having a water passage formed therein and a central axis about which said rotatable nozzle housing rotates; and

5 a [[relatively flat]] nozzle plate having [[a front side, a back side, a top edge, a bottom edge and opposing side edges;]] at least one orifice disposed in said nozzle plate [[aligning]] to be aligned with [[a]] the water passage formed in said rotatable nozzle housing for discharging water from the side of said rotatable nozzle housing at a given characteristic,

10 said nozzle plate slidably fitting into a complementary groove formed into said water passage in said rotatable nozzle housing [[and disposed generally parallel to said central axis, said front side having]] so that a planar surface of said nozzle plate can be sealed to the water passage by [[facing the discharge end of said water passage, sealing means surrounding said discharge end of said water passage formed in said nozzle housing; said sealing means including]]

15 a seal member surrounding [[the discharge end of]] the water passage and dimensioned to continuously bear against said planar surface to provide a sealed connection to the pressurized water passage of the nozzle housing, [[means on the top edge of]]

wherein said nozzle plate is accessible from the top of said rotatable nozzle housing [[wherein said nozzle plate is]] so as to be removable while said sprinkler is operational for insertion of [[other]] another nozzle [[plates with different orifices]] plate having at least one orifice and having different flow characteristics from those of the removed nozzle plate.

13. (Amended) A sprinkler as claimed in claim 12, wherein said seal member is an "O" ring.

14. (Amended) A sprinkler as claimed in claim 12, including a tapered recess formed at one end of said groove and a mating tapered portion formed on said [[bottom edge and said back side]] nozzle plate to urge said nozzle plate against said seal member.

15. (Amended) A sprinkler as claimed in claim 12, including a riser operatively connected to said rotatable nozzle housing, said riser and said nozzle housing being cylindrically shaped and the outer diameter of said riser and the outer diameter of said nozzle housing being substantially equal.

16. A water sprinkler [having] comprising:
a riser assembly;[,]
a drive shaft extending from the top of said riser assembly;[,]
a nozzle housing assembly[, said nozzle housing assembly] having
5 a housing connected to said drive shaft for rotation therewith, [said nozzle housing assembly having]
a cylindrical outer surface, and
a flow passage formed therein which has an exit at said cylindrical outer surface; and
a cylindrical nozzle selection sleeve [being] mounted over the outer surface of said housing to rotate
10 therewith and being manually [rotated] rotatable relative to said housing, said nozzle selection sleeve having
a sleeve wall with a multiplicity of individual nozzles spaced therearound, [said housing having a flow
passage therein with an exit at said cylindrical outer surface,] said individual nozzles having mutually
different configurations from each other to produce respectively different flow characteristics and being
positioned on said sleeve wall so that each nozzle becomes aligned with said flow passage exit as the nozzle
15 selection sleeve is rotated.

17. (Amended) A water sprinkler as claimed in claim 16, wherein each of said individual nozzles includes a sharp edged orifice formed therein in the process of molding the nozzle selection sleeve.

18. (Amended) A water sprinkler as claimed in claim 16, further including [[sealing means]] a seal surrounding said flow passage exit to provide a sealed connection [to] between the nozzle housing and the selection sleeve around the pressurized [water] flow passage of the nozzle housing to prevent water exiting the flow passage and through the nozzle aligned with the flow passage exit from leaking.

19. (Amended) A water sprinkler as claimed in claim 18, wherein said [[sealing means]] seal includes an "O" ring.

20. A sprinkler as claimed in claim 1, wherein the rotatable sleeve is removably installed on the nozzle housing.

21. A water sprinkler as claimed in claim 16, wherein the nozzle selection sleeve is slidably removable from said housing.

22. (New) A sprinkler comprising:

a riser assembly;

a rotatable nozzle housing having a flow passage formed therein for discharging water therefrom;

a drive shaft extending from the riser assembly and connected to the nozzle housing for rotating the

5 nozzle housing relative to the riser assembly; and

at least one selectable nozzle arrangement for aligning one of a plurality of nozzle orifices with the flow passage to distribute water from the sprinkler according to desired flow characteristics, wherein the plurality of nozzle orifices are each configured mutually differently to provide different flow characteristics, and wherein a selected one of the plurality of nozzle orifices to be aligned with the flow passage can be
10 changed while the sprinkler is operational.

23. (New) The sprinkler according to claim 22, wherein the at least one selectable nozzle arrangement includes at least one nozzle plate each having at least one orifice disposed therein.

24. (New) The sprinkler according to claim 23, wherein the nozzle housing has a groove formed therein, whereby a nozzle plate can be slidably fitted into the groove and accessed from the top of the nozzle housing so as to be mountable in the nozzle housing while the sprinkler is operational and similarly removable therefrom for insertion of another nozzle plate having another of the plurality of differently
5 configured nozzle orifices.

25. (New) The sprinkler according to claim 23, wherein each nozzle plate is mountable in the nozzle housing so as to intersect the flow passage to align the selected one of the differently configured nozzle orifices with the flow passage, whereby a pressurized flow of water flowing through the flow passage is forced through the selected nozzle orifice to achieve the desired flow characteristics.

26. (New) The sprinkler according to claim 23, wherein the at least one nozzle plate includes a nozzle plate having an insertable nozzle inserted into the plate.

27. (New) The sprinkler according to claim 22, wherein the at least one selectable nozzle arrangement includes a nozzle sleeve mountable around and dismountable from the rotatable nozzle housing, the nozzle sleeve being rotatable relative to the rotatable nozzle housing and having the plurality of nozzle orifices formed therein.

28. (New) The sprinkler according to claim 22, wherein the selectable nozzle arrangement is removable from the sprinkler housing while the sprinkler is operational so as to be exchangeable.

29. (New) A sprinkler comprising:
a riser assembly;
a rotatable nozzle housing having a flow passage formed therein for discharging water therefrom;
a drive shaft extending from the riser assembly and connected to the nozzle housing for rotating the
5 nozzle housing relative to the riser assembly; and
a nozzle plate including a selected orifice therein to be aligned with the flow passage for discharging
water from the rotatable nozzle housing according to a desired flow characteristic.

30. (New) The sprinkler according to claim 29, wherein the nozzle plate is fitted into a complementary opening formed in the rotatable nozzle housing to intersect the flow passage to force a pressurized water flow through the selected orifice to provide a desired precipitation rate for a desired arc of coverage.